

REMARKS**I. Status of the Application**

Claims 1-17 are pending in this application. In the November 16, 2007 final office action (the “Final Office Action”), the Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over US 7,124,397 to Mathur et al. (hereinafter “Mathur”) and US 6,922,558 to Delp et al. (hereinafter “Delp”)

In this case, applicant respectfully traverses the examiner’s rejection of claims 1-17. Applicant has also amended claim 17 to place the claim in better condition for allowance or appeal.

II. The Rejection of Claims 10-15 Should Be Withdrawn

In the Final Office Action, the examiner rejected claims 10-15 under 35 U.S.C. § 103(a). Applicant respectfully notes that claims 10-15 were cancelled in Applicant’s May 11, 2007 response. This cancellation is also shown in the listing of claims included with this response. Accordingly, it is respectfully submitted that the examiner’s rejection of claims 10-15 is moot and should be withdrawn.

III. The Rejection of Claims 1 and 6 Should be Withdrawn

In the Final Office Action, the examiner rejected claims 1 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Mathur and Delp. In this response, Applicant respectfully traverses the Examiner’s rejection of claims 1 and 6 under 35 U.S.C. § 103(a), as the Examiner has failed to make a *prima facie* case of obviousness as described in MPEP §2142-2143.

Pursuant to MPEP 2143, “**the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”**

Furthermore, in order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.03.

A. The Examiner Has Not Clearly Articulated the Reasons Why the Claimed Invention Would Have Been Obvious

In the Final Office Action, the examiner provided the following rationale why the invention of claim 1 would be obvious:

“It would have been obvious to a person with ordinary skill in the art to have the system in Mathur et al be for building control because it would provide a convenient environment for power control integration of third party vendor devices. This building control system would be separately housed than the field panel, as follows from the separate housing in Delp et al. In the event this may not be clear, the Examiner takes Official Notice that it would have been obvious to a person with ordinary skill in the art to have the building control housed separately, because this would allow a convenient and organized environment for power control integration of third party vendor devices.

(p. 3 of Final Office Action)(emphasis added).

Applicant respectfully submits that the foregoing position by the examiner is not a “clear articulation of the reasons why the claimed invention would have been obvious” for several reasons, as set forth below.

1. The Examiner’s Rationale For Obviousness is Merely Conclusory.

In the Final Office Action, the examiner’s primary rationale for finding that the claimed invention appears to be that the system disclosed in Mathur could be used for building control “because it would provide a convenient environment for power control integration of third party vendor devices”. Applicant respectfully submits that this position by the examiner that the field of building control would have been a “convenient environment” for power control of third party vendor devices is merely a conclusory statement, and is not a “clear articulation of the reason(s) why the claimed invention would have been obvious” as required by MPEP § 2143. The examiner has provided no specific reasons why the system of Mathur would be useful in the system of Delp. Moreover, the examiner has not articulated why Delp would provide a “convenient environment for power control of third party vendor devices.” Instead the examiner has simply suggested that the subject matter of Delp would be a “convenient environment” to incorporate the subject matter of Mathur. Applicant respectfully submits that the conclusory statement offered by the examiner for a finding of obviousness is no more than impermissible “hindsight”. Accordingly, for at least this reason, the examiner has failed to make a *prima facie* case of obviousness under MPEP § 2143.

2. The Examiner's Statements Concerning Obviousness are Unclear

In addition to the above, it is respectfully submitted that the examiner's statements concerning obviousness are unclear in the Final Office Action. For example, in the Final Office Action, the examiner stated that the “*building control system*” would be separately housed from the *field panel*, as follows from the separate housing in Delp et al.” Applicant respectfully requests clarification concerning the foregoing statement. In particular, how does Delp show a “*building control system*” housed separately from a “*field panel*”? Furthermore, what is the relevance of a “*building control system*” that is housed separately from a “*field panel*”? Applicant notes that in claim 1 of the present application the “*workstation*” is housed separately from the “*field panel*”, but there is no suggestion of a “*building control system*” housed separately from a “*field panel*. In view of the foregoing, the examiner's statement concerning the “*field panel*” and “*building control system*” of Delp is entirely unclear. It is also unclear how this statement applies to the examiner's finding of obviousness. Accordingly, the examiner has not clearly articulated the reasons why the claimed invention would have been obvious, and for at least this reason, the examiner has not made a *prima facie* case of obviousness under MPEP § 2143.

3. The Examiner's Use of “Official Notice” is Inappropriate

In the Final Office Action, the examiner improperly incorporated the concept of “*official notice*” into the finding of obviousness. As set forth in MPEP § 2144.03, “the examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known”.

In the present case, the examiner takes “Official Notice that it would have been obvious to a person with ordinary skill in the art to have the building control housed separately”. This “Official Notice” by the examiner in the November 16, 2007 Final Office action is clearly not a fact outside of the record which is capable of instant and unquestionable demonstration as being “well-known”. Accordingly, applicant respectfully submits that the examiner should withdraw this “official notice”. Moreover, for at least this reason concerning “official notice”, the examiner has not clearly articulated the reasons why the claimed invention would have been obvious, and the examiner has not made a *prima facie* case of obviousness under MPEP § 2143.

B. The Cited References Do Not Teach or Suggest All Claim Limitations

In the present case, it is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness for at least the reason that neither Mathur nor Delp teach or suggest all the limitations of claims 1 and 6, either alone or in combination.

One example of a limitation of claim 1 that is not taught or suggested by the cited references is that of “loading the generated integration file into the separately housed field panel for use by the drive associated with the third party device.” Claim 6 includes a similar limitation.

In the November 16, 2007 Office action, the examiner argues that the foregoing limitation is found in Figure 13 and column 5 lines 50-67 through column 6 lines 1-15 of Mathur. (See page 3, lines 4-6 of November 16, 2007 Office action). The examiner makes no claim that the foregoing limitation is found in Delp.

In Applicant's May 11, 2007 Response to Office action, applicant set forth arguments that the foregoing limitation was not found in Mather. In particular, in that May 11, 2007 Response to Office action, applicant noted that Figure 13 of Mathur shows interfaces between various applications and programs in the workstation itself, but does not show any elements of portions of a separately housed field panel. In addition, applicant noted that the columns 5 and 6 of Mathur discuss how various applications within the control workstation cooperate to build an interface to a field device, but none of the text mentions downloading information, much less and integration file, into the field device. Applicant respectfully reiterates the foregoing arguments herein related to Mathur. In particular, it is respectfully submitted that Mathur makes no disclosure "loading the generated integration file into the separately housed field panel for use by the drive associated with the third party device."

In the November 16, 2007 Final Office action, the examiner did not respond to any of applicant's arguments concerning Mathur and the limitations of claims 1 and 6. Instead, the examiner simply stated that "Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection" (see page 7 of the Final Office Action). However, the examiner simply repeated the same arguments from the previous office action of January 11, 2007 in the Final Office action. Should the examiner maintain the current rejection of claims 1 and 6, it is respectfully submitted that the examiner should address applicant's arguments and clearly indicate how the cited portions of Mather disclose the limitation of "loading the generated integration file into the separately housed field panel for use by the drive associated with the third party device."

As set forth above, neither Mathur nor Delp teach or suggest the limitation of “loading the generated integration file into the separately housed field panel for use by the drive associated with the third party device.” Therefore it is respectfully submitted that the Examiner has failed to present prior art that teaches or suggests all the limitations of claims 1 and 6. Accordingly, the Examiner has not made a *prima facie* case of obviousness, and the 35 U.S.C. 103(a) rejection of claims 1 and 6 should be withdrawn.

IV. The Rejection of Claim 16 Should be Withdrawn

In the Final Office Action, the examiner rejected claim 16 under 35 U.S.C. § 103 as being unpatentable over Mathur and Delp. It is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness for at least the reason that neither Mathur nor Delp teach or suggest all the limitations of claim 16, either alone or in combination.

One example of a limitation of claim 16 that is not taught or suggested by the cited references is that of “transmitting, by the field panel, the stored appended field modification to the workstation.” In the Final Office Action, the examiner argues that the foregoing limitation is found in Figure 13 and column 5 lines 50-67 through column 6 lines 1-15 of Mathur. (See page 6, lines 13-15 of the Final Office Action). The examiner makes no claim that the foregoing limitation is found in Delp.

In Applicant’s May 11, 2007 Response to Office action, applicant set forth arguments that the foregoing limitation was not found in Mather. In particular, in that May 11, 2007 Response to Office action, applicant noted that none of the cited portions of Mathur relate to or discuss data transmitted to, or data received from, a field device 100. As discussed above in connection with claim 1, these cited portions of Mathur relate only to the workstation.

In the Final Office Action, the examiner did not respond to any of applicant's foregoing arguments concerning Mathur and the limitations of claim 16. Instead, the examiner simply stated that "Mather does in fact show transmitting the stored appended field modification data." (see page 7 of the Final Office Action). However, the examiner did not cite any new portion of Mathur or further explain how Mathur discloses this limitation. Should the examiner maintain the current rejection of claim 16, it is respectfully submitted that the examiner should address applicant's arguments and clearly indicate how the cited portions of Mather disclose the limitation of "transmitting, by the field panel, the stored appended field modification to the workstation."

As set forth above, neither Mathur nor Delp teach or suggest the limitation of "transmitting, by the field panel, the stored appended field modification to the workstation." Therefore it is respectfully submitted that the Examiner has failed to present prior art that teaches or suggests all the limitations of claim 16. Accordingly, the Examiner has not made a *prima facie* case of obviousness, and the 35 U.S.C. 103(a) rejection of claim 16 should be withdrawn.

V. **The Rejection of Dependent Claims 2-5, 7-9 and 17 Should Be Withdrawn**

Dependent claims 2-5, 7-9 and 17 all depend from and incorporate all the limitations of one of allowable independent claims 1 or 6. Moreover, each of these dependent claims includes additional novel and non-obvious limitations. Accordingly, it is respectfully submitted that dependent claims 2-5, 7-9 and 17 are also allowable for the same reasons that independent claims 1 and 6 are allowable, as well as additional reasons.

VI. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

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Respectfully submitted,



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